

REMARKS

Applicants appreciate the Examiner's attention to the above referenced application. Reconsideration of the application is respectfully requested. Claims 19-22 are amended to recite an "apparatus" rather than a "system," for clarity only. Claims 1-22 were rejected. Claims 1-22 are now pending, of which claims 1, 10 and 19 are independent.

§ 101 Rejection of the Claims

Claims 1-22 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein.

The Examiner attempts to assert that Claims 1, 10 and 19 are non-statutory. However, the Examiner's reasoning is faulty and improper.

As for Claim 1, the Examiner asserts that the preamble states "recites" "... a computer-implemented *method* of correlating traditional printed material to a response produced by a computer system ..." There is no reasoning given as to the rejection, however. Claim 1 falls into the statutory category of a "process" and is there are no exceptions listed by the Examiner. Therefore, this rejection should be withdrawn and a new non-final office action generated.

As for Claim 10, once again, the Examiner reiterates the preamble, but does not discuss why this is non-statutory. As discussed in the previous office action response, Applicants have amended the preamble to recite "... a computer readable storage medium having a plurality of machine accessible instructions stored thereon." [emphasis added]

Claim 10 and its progeny were previously amended to more clearly recite the preamble as "*A computer readable storage medium having a plurality of machine accessible instructions stored thereon, wherein when the instructions are executed by a processor, the instructions cause the processor to correlate traditional printed material to a response produced by a computer system by.*" The Specification describes the term "machine readable medium" as including "solid-state memories, optical and magnetic disks, and a carrier wave that encodes a data signal." However, the recitation in the claims of a "computer readable storage medium" clearly limits the claims to an article of manufacture comprising a tangible storage media,

as expressly permitted as statutory by *In re Beauregard* (citation omitted). Therefore, the rejection, at least as directed toward Claims 10-18 must be withdrawn.

As for Claim 19, the Examiner asserts that the preamble recites "a system for associating a selected object on any printed material to a valid response provided by a computer system ..." However, the Examiner does not explicitly explain why this should make Claim 19 non-statutory. 35 U.S.C. § 101 says, in part, that whoever invents a "new and useful process, machine, manufacture, or composition of matter..." may obtain a patent therefor. The Examiner has not provided any exceptions to explain why this system should not be patentable. In an effort to clarify that Claim 19 falls within the "machine" category, the preambles of Claims 19-22 are amended to recite "An apparatus." Thus, this rejection should be withdrawn.

The Examiner then goes on to assert that the Specification defines a computer readable medium as including a carrier wave. However, the Examiner does not provide any explanation as to how this even remotely relates to Claims 1, 19 and their progeny. First, with respect to Claims 1 and 19, no recitation in the claim even implies that a computer readable medium is a component of the method or system, especially not one that might be construed as a carrier wave. Thus, the Examiner fails to provide any explanation of why the claims are non-statutory and this rejection should be withdrawn.

Second, as for Claim 10, Applicants have already amended and explained why the rejection should be withdrawn, both above, and in the previous office action response. Again, the Applicants are entitled to explain their invention in any manner which will inform the reader. However, the *claims* define the metes and bounds of the protected invention. Therefore, the Applicants are entitled to *limit* their claimed invention to statutory storage medium, even though it is conceivable that their invention *could* be implemented in a carrier wave, seemingly without patent protection. Thus, this rejection should be withdrawn.

§112 Rejection of the Claims

Claims 1, 10, and 19 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein.

The Examiner asserts that the subject matter recited as "the traditional printed material is *not directly or communicatively coupled* to the computer system" is not found in the Specification as originally filed. [emphasis added] Applicants respectfully disagree. The Examiner is directed to the Specification, page 5, lines 1-7, where it is described:

"a computer system 102 interacts with a **traditional paper book** 104 being read by a user. The term "book" as used herein may be any pre-existing printed material, such as a fiction or non-fiction book, a periodical such as a magazine, newspaper, or a journal, a coloring book, a pamphlet, an advertisement, and so on. The **book may be placed by the user so as to reside on a book holder** 106, which **holds the book** in a fixed relationship to a receiver device 108."

Also see page 5, beginning at line 26, where it is described that:

"Embodiments of the present invention may be used as follows. The receiver 108 may be fixed on top of the **book holder** 106, while the **book 104 is put on the book holder** by the user. This means the distance between the book and receiver is fixed. In at least one embodiment, the fixed relationship may include one corner and two sides of the book being situated against a fixed 90 degree angle structure of the book holder."

It will be understood by one of ordinary skill in the art that a book may be placed, put or set into or on top of a book holder. There is no coupling either described or implied. The fact that a user may put the book on the holder makes it implicit and inherent that the book is removable from the book holder. The book holder *holds* the book. The book is not coupled to the book holder. Of course, since the book is a traditional paper (or linen, cardboard or other material) book, it cannot "communicate" in and of itself anyway, so this limitation is inherent in the definition of a **traditional paper book**. The Examiner should be directed again, to Figure 1, and its description. It will be apparent that a book is placed onto a book holder in a specific juxtaposition so that the position of the book is fixed, as relative to the book holder. Any communication to the device is to the receiver 108, which is typically coupled to the book holder, as shown in Figure 1. However, the book itself is not coupled to the book holder, and may be removed and replaced with another book, as long as the multimedia information corresponding to that book are loaded into the database. Throughout the Specification the term "current book" is used. It will be apparent to one of skill in the art that by using the term

"current" to qualify the book, that a plurality of books may be placed in the book holder to utilize the device with different content. It should also be noted that the book itself is not part of the device. The use of a book is integral to the *use* of the device, and the ability to place a book on the device (book holder) and replace it with a different book is a feature not found in the prior art.

The Examiner also rejects the Claims under § 112, second paragraph. However, it will be apparent to one of ordinary skill in the art, after reading the Specification and viewing the Figures, that the book holder is coupled to the receiver (see Fig. 1). The receiver is communicatively coupled to the computer system and electronic pen. The book, however, is placed onto the book holder and is neither "coupled" to it, or has any method of communication. The placement of the book, and the book identification may be used to derive the location of the pen in relation to any content on the page, because once placed in the book holder, the relative positions of the book content and receiver are known, based on knowledge of which book is placed in the holder, as described in the Specification. The prior art cited is for electronic books. Applicants do not describe an electronic book, but the ability to take a traditional paper book and apply multi-media actions by placing the book in a device that can track pen movement over page content.

§102 Rejection of the Claims

Claims 1-5, 8-14, and 17-22 remain rejected under 35 U.S.C. § 102(b) as being anticipated by Ohara et al. (Us Patent No. 5739814). Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein.

The Examiner has misunderstood an important aspect of Applicants' invention. The Examiner cites Ohara as prior art. However, Ohara is directed to an electronic book. The pages of the book are permanently fixed to a computer system and pointing device, keys or other input device. This electronic book may have several programs installed so that interaction with the book, by a user, may take on a variety of scenarios. In contrast, the claimed invention is directed toward *linking objects in traditional printed material*, most often paper, with a set of responses to be performed by a computer system. Thus, Applicants' invention allows a user to link many different books with many different multimedia responses via the same system.

Claims 1 and 10 have been amended to recite that the printed material is “traditional printed material,” i.e., a paper book, brochure, pamphlet, magazine, etc. Further, Claims 1, 10 and 19 have been previously amended to explicitly recite that the printed material is not directly or communicatively coupled to the computer system. This subject matter is discussed in the Specification as originally filed, as shown above. Thus, this, at least, distinguishes the claimed invention from the cited electronic book. An electronic book, by definition, has pages coupled to the device containing a processor. Moreover, the claims are further amended to more clearly recite that the position on the page is defined by a relative position of the traditional printed material to a known physical location of a printed material holder. In other words, the printed material in the present invention is placed in the printed material holder before defining objects on the page. The printed material holder keeps the printed material in a fixed location with respect to the holder, so that a user may define a location within a page. It will be apparent to one of skill in the art that if the book material is moved in relation to the book holder, while in use, that errors in positioning may result. Thus, it will be apparent that the book *could* be temporarily fastened or clipped to the book holder to inhibit movement, while in use. However, the book is not permanently *coupled* to the book holder because this is contrary to the inherent value of the device that it may be used with more than one book. Any printed material may be placed in the holder and linked to computer system responses, and is not limited to pre-fixed pages, as in an electronic book. These features are not taught or suggested by the cited reference. Thus, the rejection should be withdrawn.

§103 Rejection of the Claims

Claims 6-7 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohara et al. (US Patent No. 5739814). Applicants respectfully traverse this rejection, which should be withdrawn for at least the reasons set forth herein.

Once again, the Examiner confuses the electronic book system with the claimed system and method for linking objects of traditional printed material. This rejection is believed moot based on the above amendments and discussion.

All claims remaining in the application are now believed allowable.

CONCLUSION

Applicants respectfully request reconsideration in view of the remarks and amendments set forth above. If the Examiner has any questions, the Examiner is encouraged to contact the undersigned at **703-633-6845**. Please charge any shortage of fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-0221 and please credit any excess fees to such account.

Respectfully submitted,

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